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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,364	10/16/2003	Douglas Eggleston	1743-000001	9280

27572 7590 10/20/2005

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EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,364

Applicant(s)

EGGLESTON, DOUGLAS

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's amendment filed 9/15/2005.

Status of Claims

- [1] Claims 1-3, 6-9, 11 are pending.

Specification

- [2] The disclosure was previously objected to for informalities. Applicant has successfully addressed these issues in the amendment filed on 9/15/2005. Accordingly, the objection(s) to the specification have been withdrawn.

Claim Objections

- [3] Claim(s) 1 was previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 9/15/2005. Accordingly, the above objection(s) to the claim(s) 1 have been withdrawn. In view of further examination, however, further objections were found to a number of claims, beginning again with Claim 1.

Claim 1 recites the limitation "the group" "the outer periphery" and "the entire periphery" in the instant claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 2 recites the limitation "the group" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the range" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 11, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Regarding claim 11, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim 11 recites the limitation "the group" "the outer periphery" and "the entire periphery" in the instant claim. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 103

[4] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[5] Claims 1-3, 6-9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cacciatore et al., US-5,950,287, in view of Spater et al. US-4,697,061.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Cacciatore et al. teaches of an neck chain (29) supported pendant (28) for carrying organic material (apparatus for containing cremation ashes) said pendant comprising:

a first (12) and second (17) substantially identically shaped concave housing members disposed in aligned confronting relationship (Fig. 1) and defining an organic material chamber there between (apparatus for containing cremation ashes),

said housing members (12, 17) fabricated of a thin metallic material and having integral head sacrificial rim portions (11, 15) extending continuously around the outer periphery thereof,

said rim portions (11, 15) of said housing members (12, 17) disposed in contact with one another around the entire periphery of the pendant and being fixedly joined to one another (the closing of the device from Fig. 1a), and of a trim element disposed substantially entirely around the pendant (11, 15).

However, Cacciatore et al. fails to disclose expressly that a laser welding operation joins the rim portions of the housing members to one another, and that the housing members are fabricated solely of a precious metal material chosen from the group of karat gold's, sterling silver, titanium, palladium, and platinum.

“so as to hermetically seal said chamber, the heat of which operation results in the sacrificing of said rim portions in a manner as to not adversely affect the organic material in said chamber,” and “substantially concealing the laser welding joint securing said housing members together” are examples of intended use as they do not further limit the structure of the claimed invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Spater et al. teaches of a method for welding by means of laser light, in which a method for laser-light welding of a metallic base layer to a thin, metallic covering lying thereon is taught.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the seal between the housing members of the apparatus for containing cremation ashes as taught by Cacciatore et al., to utilize a laser-welding method to connect the two members as taught by Spater et al., in order to create a more efficient bond or seal between respective housing/rim members of the pendant, and as Spater et al. states in column 1, line 45, "...allowing a particularly high strength of connection between the base layer and the covering to be achieved with high reliability."

Further, with regard to the latter, it must be understood that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material.

As for Claim 2, wherein said housing members have a shape selected from the group consisting of round, oval, teardrop, rectangle, square, triangle, heart, and cross-shaped (Fig. 2 of Cacciatore et al.).

Re: Claim 3, wherein said neck chain is slidably attached to said pendant through a welded loop on said trim element (loop 20 in Fig. 2 of Cacciatore et al.).

Re: Claim 6, wherein said laser welding operation utilizes a power between the range of 180-280 volts (Claim 6). "" utilizes a welding contact duration of between 2.0 and 6.0 milliseconds (Claim 7). "" utilizes a laser beam having a width between .6 and 1.6 millimeters

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(Claim 8). "" utilizes a pulse repetition frequency of 1.0-4.0 hertz (Claim 9). These instant claims revolve more around the process of creating the product than with the product itself. As a result, nominal patentable weight is given to these claims. One, because they are process claims, and two, because it would be readily apparent to one skilled in the art of the potential use of different laser welding operation properties dependent on the specific intensity, duration, etc. initially required to achieve a specific type of weld.

The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

As for Claim 11, the above rejections are maintained, as the instant claim is merely a combination of said claims 1-9.

Response to Arguments

[6] Applicant's arguments filed 9/15/2005 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. To begin, the applicant states that, "the laser welding technique which yields the product in Applicant's invention is not taught, anticipated, nor rendered obvious by either the 287' nor the 061' prior art. In response, though Spater et al. does indeed teach of such a technique, the examiner would also like to point out that such a welding technique as described above is an example of a product-by-process claim. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976). It is therefore, once again, the claimed structure of the product that is patentable, not the process or technique used to obtain said claimed structural subject matter. To better claim the intended subject matter, examiner

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suggests that applicant attempt to describe the structural differences between the prior art and the instant invention after the fact as a result of the technique instead of attempting to claim the technique and the different characteristics of using said technique (power, duration, width, etc.).

Further, in response to Applicant's piecemeal analysis of the references, especially with regard to the discussion regarding the seal, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

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Conclusion

[7] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. **Please also note the change in the fax phone number to (571) 273-8300 for the organization where this application or proceeding is assigned.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR


ROBERT J. SANDY
PRIMARY EXAMINER